

## REMARKS

Applicant respectfully requests consideration of the subject application. This Response is submitted in response to the Office Action mailed December 22, 2008. Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45-46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 are pending. Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 are rejected. Claims 1, 17, 31, 45, 54, 56, 58, 72, 74, and 78-82 have been amended. No new matter has been added.

### 35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 under 35 U.S.C. § 103(a) as being unpatentable over Thomas, (U.S Patent No.: 6,128,663, hereinafter “Thomas”) in view of Official Notice.

Presently amended claim 1 is patentable over the cited prior art at least because Thomas, in view of Official Notice, fails to teach or suggest serving a World Wide Web, serving said advertisement for display to said user on a portion of said World Wide Web page such that at least a portion of the content included in said World Wide Web page is still displayed to the user, tailoring said message page based, at least in part, on said targeting criteria and said personal information and serving said tailored message for display to said user on said World Wide Web page separate from said advertisement such that at least a portion of the content included in said World Wide Web page and the advertisement is still displayed to the user as required by claim 1.

In *Thomas*, column 4, lines 53-65 state as follows:

“A remote server receiving a page request (e.g., from such modified pages or modified page requests) is able to obtain the demographic identifier and use the demographics identifier to modify the content of the requested page to be transmitted over the network to the user such that it is more appropriate for the user. For example, the requested page often includes an advertising banner, and according to the invention, the particular advertising banner that is chosen to be transmitted with the requested page is determined, not randomly, but in accordance with the demographics identifier. Other modification could also be made such as providing a greeting, selecting an appropriate variant of the requested page or portion thereof, etc.” (Emphasis added)

As noted in Applicants’ Appeal Brief, the greeting of *Thomas* is not related to the advertisement. Just because selection of an advertising banner to be displayed is based on a demographic profile and selection of a greeting to be displayed is based on a separate demographic profile does not mean that the greeting is related to the advertisement in general, or thematically related to the advertisement in particular. For example, a served World Wide Web page may include an advertisement directed to restaurants that is selected based on a demographic of people earning \$20,000 to \$30,000 and an advertising banner directed to a department store that is selected based on a demographic of people earning \$20,000 to \$30,000. Although both the advertisement and the banner ad were selected using demographic information, the demographic information of the advertisement is clearly not thematically related to the demographic information of the banner ad. Thus, claim 1 includes at least one limitation that is not suggested by *Thomas*.

Examiner’s response to this argument is that “*Thomas* teaches the requested page being equivalent to the Applicant’s advertisement, [because] the claims do not exclude

the advertisement from being a requested page. Applicant's claimed tailored message being the banner ad of Thomas which contains a greeting about the user and information about the requested page." Examiner's Answer, page 6. Thus, Examiner's argument relies on the assumption that the requested page of the present claims is the same as the advertisement of Thomas because the claims do not exclude the advertisement from being the requested page. The present claims have now been amended to exclude the case wherein the claimed requested page is an advertisement. Thus, for at least the reasons provided above, the banner ad and greeting of Thomas bear no resemblance to the requested page, advertisement, and message of the present claims.

#### **Official Notice**

The Examiner has taken Official Notice of the following:

1. That it is old and well-known to receive personal information from a user such as a user's name, age and gender when a user fills out an application and the like;
2. That placing a message proximal to an ad or within the advertisement is old and well-known to bring the user's attention to the ad;
3. That it is old and well-known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed;
4. That changing display attribute within a message such as changing display color or image will bring the user's attention to the message; and
5. That it is old and well-known to serve default messages when targeting criteria hasn't been met. For example, default messages for or general messages are displayed to the customer when the customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

Even if the Applicants agreed with the Examiner's taking of Official Notice of the above points, they still fail to overcome the above noted deficiencies of Thomas. As such, the combination of Thomas and Official Notice fails to teach or suggest each and every element of the present claims.

Furthermore, Applicants respectfully reject as improper the Examiner's taking of Official Notice of the above and note that the Examiner has failed to provide prior art and convincing arguments for why such prior art would be integrated with Thomas by one skilled in the art. Applicants note that the present application was filed on June 3, 2002 and respectfully assert that the prior art requested by Applicants would not be combined with Thomas by someone of ordinary skill in the art at the time that the invention was made.

Thus, for at least these reasons, Thomas and Official Notice, whether considered alone, or in combination, fail to teach or suggest each and every element of claim 1. All the other claims rejected by the Examiner have limitations similar to those recited in claim 1 and are patentable over Thomas in view of Official Notice for at least the same reasons as claim 1. Therefore, the present claims are patentable over Thomas in view of Official Notice.

Applicant respectfully submits that the present application is in condition for allowance.

Please charge any shortages and credit any overages to Deposit Account No. 19-3140. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 19-3140.

Respectfully submitted,  
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